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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/766,209	01/19/2001	Brandon J. Passanisi	P5505/14695.007001	9219
32615	7590	03/01/2005	EXAMINER	
OSHA & MAY L.L.P./SUN 1221 MCKINNEY, SUITE 2800 HOUSTON, TX 77010				VU, TUAN A
ART UNIT		PAPER NUMBER		
2124				

DATE MAILED: 03/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/766,209	PASSANISI, BRANDON J.	
	Examiner	Art Unit	
	Tuan A Vu	2124	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 9/24/2004.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1,3-11,13-18 and 20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1,3-11,13-18 and 20 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____. | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____. |

DETAILED ACTION

1. This action is responsive to the Applicant's response filed 9/24/2004.

As indicated in Applicant's response, claims 1, 3-4, 11, 18 have been amended, and claims 2, 12 and 19 canceled. Claims 1, 3-11, 13-18, and 20 are pending in the office action.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 1, 3-10, 11, and 13-17 rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The Federal Circuit has recently applied the practical application test in determining whether the claimed subject matter is statutory under 35 U.S.C. § 101. The practical application test requires that a "useful, concrete, and tangible result" be accomplished. An "abstract idea" when practically applied is eligible for a patent. As a consequence, an invention, which is eligible for patenting under 35 U.S.C. § 101, is in the "useful arts" when it is a machine, manufacture, process or composition of matter, which produces a concrete, tangible, and useful result. The test for practical application is thus to determine whether the claimed invention produces a "useful, concrete and tangible result".

Claim 1 recites a module comprising a plurality of development tools used for creating JES bundles, the module being adapted for inclusion in an IDE. The module and the included tools appear to be mere descriptive elements when it is required that there should be action steps taking into account interaction between them or their interrelationship to yield a result in the useful arts. Notwithstanding the fact that the term 'adapted for' does not particularly enforce an actual operation/action being taken, the claimed descriptive elements stand without any action being actually taken that would lend sufficient knowledge that the very action can achieve a useful, concrete and tangible result. Therefore, the claim does not fulfill the requirements of the

practical application test from above; hence, the claim merely amounts to an abstract idea, and is rejected for leading to a non-statutory subject matter.

Claim 11 recites a method combining a module and integrating the module tools into an IDE. There is insufficient support in the claim as to enable one skill in the art be appraised that the module, the tools and the IDE – all of which construed as software entities - are implemented into a hardware device or via a computer or a computer-readable medium. Hence, the claim merely amounts to putting together non-practical non-tangible concepts, and is rejected for leading to a non-statutory subject matter.

The dependent claims of claims 1, and 11 are rejected as well for failing to remedy to the deficiencies of the base claims.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The limitation recited as ‘module is adapted for’ (line 4) does not define whether an action is actually taking place. One of ordinary skill in the art would not be sufficiently apprised about the metes and bound of such limitation in order to effect a reasonable construing of the claimed invention. The limitation would be interpreted as if the ‘module’ is operated for ‘inclusion ...’

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1, 3-11, 13-18, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kobayashi, USPN: 6,633,888 (hereinafter Kobayashi) in view of admitted prior art (see Affidavit 1.132 filed 9/24/2004 and Anne Thomas' White paper -- hereinafter APA).

As per claim 1, Kobayashi discloses an apparatus for facilitating development of Java bundles, comprising: a module comprising a plurality of development tools (e.g. Fig. 7) used in the creation of Java bundles (e.g. *JAR file* - step 808, Fig. 8; step 1910, Fig. 19; col. 7, lines 45-55); wherein the module is adapted for inclusion in a IDE (e.g. *IDE* 712 – Fig. 7; col. 11, lines 26-30)

But Kobayashi does not disclose that the Java bundles are Java Embedded Server bundles. The use of Java compacted packages like JAR in network distribution to facilitate their deployment at target devices where storage resources are limited, e.g. resources-restraint embedded devices where was a known concept at the time the invention was made. This concept is evidenced via embedded systems with capabilities to install and deploy portable package of software such as the likes Java Embedded Servers as taught by APA (see Affidavit 1.132 filed 9/24/2004 and Anne Thomas' White paper). Based on Kobayashi's suggestion that cross-platform Java packages (or JAR files) or bytecodes can be deployed on embedded processing units (e.g. step 808, Fig. 8; col. 7, lines 19-30) it would have been obvious for one of ordinary skill in the art at the time the invention was made to implement the Java package builder method

by Kobayashi so that the Java bundles are created using a IDE as mentioned above for facilitating the user-driven and dynamic creation and deployment at embedded systems in general and in JES in particular as by APA because, by bundling Java deployable components in small devices (or dedicated servers like JES) whose resources can be a limiting factor, the embedded systems (e.g. JES as one intended use) storage resources for otherwise non-bundled components would be alleviated, and also because according to APA, this IDE building application would support dynamic and as-needed application deployment on embedded systems utilizing, among other benefits, the known transportability of Java bytecodes (as mentioned by Kobayashi col. 7, line 46 to col. 8, line 7), whose implicit cross-platform portability can improve deployment of program components over the network as shown by JES/APA.

As per claim 3, Kobayashi discloses a window menu within a visual builder to retrieve components to assemble a Java bundle in the IDE (e.g. Fig. 13-17; step 1910 – Fig. 19; col. 11, lines 26-30); hence has disclosed implicitly disclosed drop-down menu for accessing the module as to create Java bundles.

As per claim 4, Kobayashi discloses a update mechanism in the IDE (EDIT – Fig. 11; Fig. 13-17; step 2014 – Fig. 20).

As per claim 5, Kobayashi discloses a code template (e.g. Fig. 4; Constructor bean 1000, method bean 1012 – Fig. 10 – Note: a container for Java code methods and attributes is equivalent to class templates containing elements from which to construct further code classes)

As per claim 6, Kobayashi discloses a interface template (e.g. *palette ... internal interface* - col. 17, line 62 to col. 18, 8; col. 11, lines 45-49; *environment add-on* 700– Fig. 7; Fig. 14, 17); and implementation template (e.g. *visual builder* 214 – Fig. 2; *transport API* 206 –

Fig. 2; Fig. 9—Note: using a visual palette to effect APIs and interface calls to constructs classes and methods for beans reads on implementation template) but only teaches a activator functionality based on events (e.g. Fig. 16, 18-20 – Note: visual display to applying binding and linking properties of created components and to test beans reads on activator template). Given the visual aspect of activating the created components based on the builder template thus suggested by Kobayashi, it would have been obvious for one of ordinary skill in the art at the time the invention was made to add to the visual menu-driven tool of Kobayashi a activator template with which the components can be activated or linked just as suggested above because providing all the event-based functionalities for test or dynamic binding in one such graphical container module, i.e. a template, would provide the integration tool with one differentiated graphical module encompassing all the debugging and testing functions typical of the post-implementation stages of development as suggested above prior to delivering the package as built.

As per claims 7 and 8, Kobayashi (in view of APA) discloses a Java Embedded Server (JES) manifest generator tool and jar packager tool (e.g. step 1910 – Fig. 19).

As per claim 9, Kobayashi does not disclose link to JES-related web pages but teaches a Java bean-compliant visual tool of the likes of Visual Age *WebRunner* for a world wide web with Corba connectivity (e.g. *CORBA* - col. 5, lines 23-31; col. 11, lines 8-17; col. 23, lines 22-34). The creation of links to remote network storages is implied or explicit in all visual development tool (e.g. Kobayashi: Fig. 3-9 – Note: for example, CORBA and RMI retrieval of remote beans/reuse component in a Web-based connection is implied that web page link, e.g. URL, are implicit) or in JES/APA when web and browser application-based tools (with inherent

web protocol connectivity features) are taught (see APA White Paper). Hence, it would have been obvious for one of ordinary skill in the art at the time the invention was made to create the visual builder by Kobayashi so that using a JES as mentioned in claim 1, JES-related links to remote storage or URL-directed pages are effected via browser pages are effected in the builder because these would enable retrieval of components supporting the IDE development at the JES as taught by APA and initially desired by the bean-compliant visual builder by Kobayashi.

As per claim 10, this claim recites code template, manifest generator tool, and jar packager tool. All of which limitations have been addressed in claims, 5, 7, and 8 respectively.

As per claim 11, Kobayashi (in combination with APA) discloses a method corresponding to the apparatus claim 1, including combining a plurality of development tools in a module for a JES and integrating the module into an IDE as recited in claim 1; hence is rejected using the corresponding rejection as set forth therein for each limitation.

As per claim 13, Kobayashi discloses code samples (refer to rejection of claim 5).

As per claims 14 and 15, these claims correspond to the limitations of claims 7 and 8, hence are rejected with the corresponding rejection as set forth therein respectively.

As per claim 16, refer to rejection of claim 9.

As per claim 17, refer to claim 10.

As per claim 18, Kobayashi discloses an apparatus for facilitating development of Java bundles, comprising means for:

providing sample code segments (refer to rejection of claim 5);
creating Java manifest files for the bundles (re to rejection of claim 7); and

packaging the bundles (re claim 8); for integration into an IDE (e.g. *IDE 712* – Fig. 7; col. 11, lines 26-30), the module comprising a plurality of development tools (e.g. Fig. 7)

But Kobayashi does not disclose that the Java bundles are JES bundles nor JES manifest files. However, this JES limitation in conjunction with IDE has been addressed in claim 1 from above, making the JES manifest file limitation as being obvious as a result thereof.

As per claim 20, Kobayashi discloses an apparatus for facilitating development of Java bundles, comprising means for

combining, in a module, a plurality of development tools used in the creation of Java bundles (refer to corresponding rejection set forth in claim 1); and

integrating the module into a IDE (*IDE 712* – Fig. 7; col. 11, lines 26-30– Note: the use of IDE inherently teaches integration of all the products generated by the module into the development environment for creating the bundles).

But does not disclose that the Java bundles are JES bundles. However, this limitation has been addressed in claim 1 from above.

Response to Arguments

8. Applicant's arguments with respect to claims 1-20 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tuan A Vu whose telephone number is (272) 272-3735. The examiner can normally be reached on 8AM-4:30PM/Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kakali Chaki can be reached on (571)272-3719.

The fax phone number for the organization where this application or proceeding is assigned is (571) 273-3735 (for non-official correspondence – please consult Examiner before using) or 703-872-9306 (for official correspondence) or redirected to customer service at 571-272-3609.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

VAT
February 10, 2005

Kakali Chaki
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